PATENT
Customer No. 22,852
Attorney Docket No. 04853.0068

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	
Katsuhiko MIKOSHIBA et al.	Group Art Unit: 1647
Serial No.: 09/832,189	Examiner: Sharon L. Turner
Filed: April 11, 2001	
For: TRUNCATED REELIN PROTEIN AND DNA ENCODING THE SAME	

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In a Restriction Requirement dated September 22, 2003, the Examiner required restriction under 35 U.S.C. § 121 to one of the following groups of claims:

Group I: claims 1-4, allegedly drawn to a peptide; and

Group II: claims 5-10, allegedly drawn in part to a polynucleotide.

Within Group I, the Examiner also requires further election of a specific molecular embodiment selected from the following:

A) a truncated Reelin protein comprising an F-spondin domain and a CR-50 recognition site of a Reelin protein but containing no repeat site;

B) a peptide of (A) that is from Xenopus;

C) a peptide of (A) that is from mouse;

D) SEQ ID NO:2;

E) a deletion, substitution, or addition of SEQ ID NO:2;

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F) SEQ ID NO:4; and

G) a deletion, substitution, or addition of SEQ ID NO:4.

Within Group II, the Examiner also requires further election of a specific molecular embodiment selected from the following:

A) a DNA encoding a truncated Reelin protein comprising an F-spondin domain and a CR-50 recognition site of a Reelin protein but containing no repeat site;

B) a DNA of (A) that is from Xenopus;

C) a peptide of (A) that is from mouse;

D) a DNA encoding SEQ ID NO:2;

E) a DNA encoding a deletion, substitution, or addition of SEQ ID NO:2;

F) a DNA of SEQ ID NO:1;

G) a DNA hybridizing to a nucleic acid probe corresponding to residues 1456-2273 of SEQ ID NO:1 or degenerates of SEQ ID NO:1;

H) a DNA of SEQ ID NO:4;

I) a DNA encoding a deletion, substitution, or addition of SEQ ID NO:4;

J) a DNA of SEQ ID NO:3; and

K) a DNA hybridizing to a nucleic acid probe corresponding to residues 2053-2758 of SEQ ID NO:3 or degenerates of SEQ ID NO:3.

Applicants provisionally elect to prosecute Group I, claims 1-4, drawn to the single designated peptide (C) of Group I, with traverse.

The Examiner stated that both of the two elections (between Groups I and II and also between subgroups (A)-(G) of Group I and subgroups (A)-(K) of Group II) constitute restriction requirements and not species election requirements. Action at page 5. Applicants contend that the Examiner's second Restriction Requirement (between subgroups (A)-(G) of Group I and subgroups (A)-(K) of Group II) is inappropriate. At most, this second requirement should be a species election for the following reasons.

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The Manual for Patent Examining Procedure (MPEP) defines "species" as "the specifically different embodiments" of the genus claim, and a "generic claim" as a claim that "include[s] no material element additional to those recited in the species claims" and which must "confine the organization" covered in each of the species. MPEP § 806.04(e), (d). Here claims 1 and 5 are generic claims. Neither contains any more material elements than their dependent claims do, and each sets forth the basic structure that each of the dependent claims seek to encompass in different ways. *See* claims 1 and 5. Similarly, claims 2-4 and 6-10 can be viewed as species claims, since each includes a different specific embodiment of the associated independent claim. *See* claims 1-4 and 5-10. Thus, at most, the Examiner's second rejection should more appropriately be termed a species election. Under this scenario, while Applicants may still be required to make an election in this situation, if the Examiner were to find the elected species to be allowable, then the Examiner would have to examine each of the associated species.

Finally, the restriction is not proper because there is no burden in examining all the claims. Although the Examiner contends that "searching all of the molecules in a single patent application would provide an undue search burden," (Action at page 4), there is no burden. Within Group I, there are only four claims. *See* claims 1-4. A single search for the truncated Reelin protein claimed in claim 1, for example, should be identical to the search for the truncated Reelin protein of claim 1 which is derived from Xenopus or mice. Similarly, SEQ ID NOs:2 and 4 are truncated Reelin proteins according to claim 1, and should fall under the same search as performed for claim 1. The same situation as in Group I applies to Group II, and similar relationships can be found within the entire claims set. The Examiner has thus failed to

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demonstrate that an undue search burden is presented by the subgroups of either Group I or Group II.

Applicants provisionally elect Group I, claims 1-4, drawn to the single designated peptide (C), with traverse. For at least the above reasons, Applicants respectfully request that the Examiner reconsider the second Restriction Requirement.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 24, 2003

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